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10/723,262

11/25/2003

Osamu Furukawa

F-7930

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01/11/2005

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EXAMINER

LE, TAN

ART UNIT

PAPER NUMBER

3632

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/723,262

Applicant(s)

FURUKAWA ET AL.

Examiner

Tan Le

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-5 is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 6-13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is the second office action for Application No. 10/723,262, Slide rail, filed on 11/25/03. This application contains two claims numbered 1-13. Claims 3-13 have been added.
2. Amendment to specification and abstract filed 10/18/04 have been approved.
3. Claims 6-7 are objected to because on claim 6 and claim 7 (both on the first line), the language after "of the" appear to be missing. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP No. 2001001811 to Izumi (of record) in view of US Patent no. 6,131,871 to Bernhardt et al.

Izumi discloses the invention substantially as claimed except for the limitation that a stay is provided where both ends of which are supported on the inside faces of both inside rails and the stay is provided with a regulating mechanism. Izumi appears to teach a stay 16 (Fig. 2) where both ends of which are supported on the outside faces of the inner rails; and the stay is provided with regulating mechanism (17, 19) for regulating and maintaining a distance between both the inside rails.

Bernhardt et al. teaches a stay (38) where at both ends of which are supported on the inside faces of both inside rails for maintaining the spans and distance between the inside rails.

Art Unit: 3632

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a stay on the inside faces of both inside rails as taught in Bernhardt et al. that improved maintaining the distance between the inside rails would be expected. Nevertheless, to provide a stay on the inside faces of the inside rails would also have been obvious as mechanical design because it is well known that a stay on the inside faces of the both inside rails will reduce the size and configuration as well as will provide a strong and better holding while maintaining the distance between the inside rails.

#### ***Allowable Subject Matter***

5. Claims 8-13 are objected to, but would be allowable if rewritten to overcome to include all of the limitations of the base claim and any intervening claims.

Claims 2-5 are allowed. Claims 6-7 are objected to, but will be allowed if overcome the objection as pointed out in the office action.

#### ***Response to Arguments***

6. Applicant's arguments filed 10/18/04 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion/motivation to combine the references (page 12, first paragraph), the examiner recognizes that obviousness cannot be arbitrarily combined and that there must be some reasons why one skilled in the art would be motivated to make the proposed combination of primary

Art Unit: 3632

and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taking as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). It also has been held that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one skilled in the pertinent art. In re Bozek, 163 USPQ 545 (CCPA 1969).

In response to applicant's arguments that the references do not teach the "regulation mechanism for adjusting and maintaining a distance between both said inside rails" (Page 12, 2<sup>nd</sup> paragraph), the examiner respectfully submits that in order to be given patentable weight, a functional recitation must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. In re Fuller, 1929 C.D. 172, 388 O.G. 279.

In response to applicant's argument that "the stay as discussed in the application, serves to resist deflection of the inside rails This is not suggested by the references". (page 13, 2 paragraph), it is noted that the features upon which applicant relies (i.e. serves to resist deflection of the inside rails,) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim 2 has been rewritten in the independent form, which includes the requirement of the allowable limitations of the claim as set forth, is therefore now allowed. Dependent claims 3-7 are also allowed.

***Conclusion***

**7. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Le whose telephone number is (703) 305-8244. The examiner can normally be reached on Mon. through Fri. from 9:00 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie Braun can be reached on (703) 308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3632

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tan Le  
Patent examiner  
December 30, 2004.



ANITA KING  
PRIMARY EXAMINER